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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,804	09/24/2001	Mari Kurosawa	SHI-015-USA-	8914
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TOWNSEND & BANTA 601 PENNSYLVANIA AVE., N.W. SUITE 900, SOUTH BLDG. WASHINGTON, DC 20004		EXAMINER WELLS, LAUREN Q		
		ART UNIT PAPER NUMBER		
		1617		

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,804

Applicant(s)

KUROSAWA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004 and 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-9 are pending. The Amendment filed 5/4/04, amended claims 1, 5, and 6. The Amendment filed 6/21/04, amended claim 6, and added claims 7-9.

The response filed 5/4/04, wherein support for the claims is specifically stated, is sufficient to overcome the 35 USC 112, 1st paragraph, rejections in the previous Office Action.

The Amendments to the claims filed 5/4/04 and 6/21/04 are sufficient to overcome the 35 USC 112, 2nd paragraph rejections in the previous Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase “titanium oxide (rutile-type), titanium oxide (micropowder)”, in claims 7-9, is confusing and renders these claims vague and indefinite. It is not clear whether the subject matter within the parentheses is further limitations and how the subject matter in the parentheses relates to the titanium oxide. As a further point, the term “rutile” is unknown to the Examiner and it is not defined in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-128122 in view of JP 9-194323.

The instant invention is directed to a kit containing (A) a first layer foundation composition and (B) a second layer finishing composition, wherein the first layer contains a silicone oil, a polyether-modified silicone represented by the formula in instant claim 1, water, and a hydrophobic powder, a second layer finishing composition containing a first powder and a second powder.

JP '122 is directed to makeup compositions comprising a first layer foundation composition and a second layer finishing composition (summary at page 3). The second layer composition comprises a diffuse reflection powder such as methyl methacrylate, nylon, mica, sericite and polyethylene, inter alia (sections 0018 to 0019 at page 10) in an amount from 5-100 wt.% (section 0022 bridging pages 11 and 12). For a second layer finishing composition containing spherical nylon powder see sections 0028-0029 at pages 14-15. The powders disclosed by JP '122 for use in the second layer composition are the same disclosed by Application as providing minimized regular reflection and diffuse reflection. See the instant specification at page 51, paragraph 2 for polymethyl methacrylate, polyethylene and nylon powders. For a first layer foundation composition containing silicone oil with a viscosity of 1cs and 20cs, see Example 3 at page 18. The reference does not teach a first layer foundation composition containing a polyether-modified silicone, water and a hydrophobic powder in addition to the silicone oil, and does not explicitly recite a kit.

JP '323 teaches a cosmetic composition containing a silicone oil, a polyether modified silicone of the formula instantly claimed, water and hydrophobic powder (page 3). For a make-up foundation composition containing the components instant claimed see Example 8 at page 22. For silicones oils containing 20-80% of the composition, for polyether modified silicones comprising 2-30% of the composition, for water comprising 0.2-80% of the composition, for hydrophobic powder comprising 1-60% of the composition, see claim 2. For powders with a refractive index of 1.3-2, see [0016]. The compositions of JP '323 provide light, refreshing feeling upon application without greasiness.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the foundation composition of JP '323 for the first layer foundation composition of JP '122 because of the expectation of achieving a foundation composition that imparts a light, refreshing feeling without greasiness, to the skin of a user.

Regarding the limitation of a kit, the Examiner respectfully points out that a composition must be contained, and that a product containing two separate compositions, as taught by both references, must be contained such that the product has two separate entities wherein the two compositions maintain their individuality. Thus, while JP '122 and JP '323 do not explicitly teach a kit, a kit is suggested. Furthermore, one of ordinary skill in the art would be motivated to generate a kit because of the ever present need to contain a single foundation product in a container wherein the fluid composition and the powder composition are joined.

Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '122 in view of JP '323 as applied to claims 1-5, 7-8 above, and further in view of Miyazawa et al. (6,326,011).

JP '122 and JP '323 are applied as discussed above. The reference lacks siliconated polysaccharide.

Miyazawa et al. teach siliconized polysaccharide as film-forming ingredients for use in cosmetic compositions. See Col. 10, lines 38-Col. 12, line 31.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the siliconized polysaccharide taught by Miyazawa et al. to the first foundation layer of JP '122 because of the expectation of achieving a foundation with transfer-resistant properties, wherein the second layer can be applied without smearing the first layer.

Response to Arguments

Applicant's arguments are all directed to their belief that the instant invention provides unexpected results over the prior art. The Examiner respectfully directs Applicant to the guidelines for showing unexpected results. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

It is respectfully pointed out that the data provided in the specification is not commensurate in scope with the instant claims. The instant claims encompass a great number of powders, oils, and other ingredients, which are not reflective of the data in the instant

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specification. Additionally, the arguments and data toward unexpected results are actually directed toward the results of the composition as applied to the skin, i.e. a method, and the instant claims are directed to a product, i.e., a composition. For this reasons it is impossible to compare the closest prior art with the invention of the instant claims.

Applicant argues, “the cited ‘122 reference fails to disclose or suggest that limiting a finishing layer containing a reduced amount of reflection powder. . .to no more than 10 wt% of the finishing layer, provides a natural appearance to the skin while simultaneously allowing the first layer of the multilayer composition to conceal irregularities in the skin”. This argument is not persuasive. As pointed out in the above rejection, JP ‘122 teach the powders as comprising 5-100%, thereby meeting the limitation of less than 10%. It is further respectfully pointed out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER